

Remarks

The Office Action mailed May 26, 2005, and made final, has been carefully reviewed and the foregoing amendments have been made in consequence thereof.

Claims 1-6 are now pending in this application. Claims 1-6 stand rejected.

The rejection of Claims 1-3 under 35 U.S.C. § 102(a) as being anticipated by Workman et al. (U.S. 5,394,757) is respectfully traversed.

Workman et al. describe a multiple stylus probe attachment (30) for probing various surfaces of a workpiece. The workpiece is positioned in the workpiece holder of a lathe. The workpiece is probed with the probing mechanism while workpiece is positioned in the workpiece holder of a lathe. The probing mechanism has a probing attachment (30), which has dual styli (34) and (36). The styli (34) and (36) are calibrated then the probing attachment (30) may be utilized to measure the surfaces of the workpiece. Notably, the styli are fixedly connected to a base (32) of the probing attachment (30) so that the styli (34) and (36) will break upon a predetermined force, thus preventing damage to the probing mechanism.

Claim 1 recites a method for inspecting a component, wherein the method comprises, “coupling the component to a fixture such that the component is fixedly secured in position during machining of the component...inspecting the component using an inspection tool while the component is coupled to the fixture, wherein the inspection tool includes a probe having at least a first and a second probe tip...positioning the first probe tip relative to the component...positioning the second probe tip relative to the component and relative to the first probe tip wherein the first probe tip is slideably coupled to the probe, and the second probe tip is slideably coupled to the probe.”

Workman et al. do not describe nor suggest a method for inspecting a component as is recited in Claim 1. Specifically, Workman et al. do not describe nor suggest a method for inspecting a component using an inspection tool including a probe having first and second probe tips that are positionable relative to each other and to the component being inspected, wherein the first and second probe tips are slideably coupled to the probe. Rather, in contrast to the present invention, Workman et al. describe styli that are fixed to a probing attachment so that the

styli will break upon a predetermined force to prevent damage to the probing mechanism. Accordingly, for the reasons set forth above, Claim 1 is submitted to be patentable over Workman et al.

Claims 2 and 3 depend from independent Claim 1. When the recitations of Claims 2 and 3 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2 and 3 likewise are patentable over Workman et al.

Accordingly, for at least the reasons set forth above, Applicants respectfully request the Section 102 rejection of Claims 1-3 be withdrawn.

The rejection of Claims 4-6 under 35 U.S.C. § 103 as being unpatentable over Workman et al. is respectfully traversed.

Workman et al. is described above.

Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to modify Workman et al. as suggested in the office action, with respect to either its structure or material. More specifically, it is respectfully submitted that a *prima facie* case of obviousness has not been established. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art, and not in the applicant's disclosure. As explained by the Federal Circuit, "the test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000), M.P.E.P. 2143. Moreover, the Federal Circuit has determined that:

[i]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight

reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fritch, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). In the present case, neither a suggestion nor motivation to modify the Workman device, nor any reasonable expectation of success has been shown.

Furthermore, in the office action, it is suggested, “[it] is deemed as well within the preview of ordinary skill in the art.” However, in Workman, if the styli are slideable coupled to the probing attachment, the measurements of the surfaces of the workpiece would be incorrect because the probing attachment uses the moment about an attachment point to measure the workpiece. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). M.P.E.P. § 2143. Furthermore, since there is no teaching nor suggestion in the cited art for the asserted modification, and since the modification renders the prior art invention unsatisfactory for its intended purpose, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, this is impermissible, and for this reason alone, Applicants request that the Section 103(a) rejection of Claims 4-6 be withdrawn.

Moreover, Applicants submit that it would not have been obvious to modify Workman et al. to obtain the claimed recitations of Claim 1. Obviousness cannot be established by merely suggesting that it would be obvious to one of ordinary skill in the art to have selected an alternative design choice. Rather, each allegation of what would have been an obvious matter of design choice must always be supported by citation to some reference work recognized as standard in the pertinent art, and the Applicants given an opportunity to challenge that correctness of the assertion or the repute of the cited reference. Applicants have not been provided with the citation to any reference supporting the combination made in the rejection.

Furthermore no modification of Workman et al. describes or suggests a method for inspecting a component as is recited in the Claims. Specifically, Claims 4-6 depend from independent Claim 1 which recites a method for inspecting a component, wherein the method comprises, “coupling the component to a fixture such that the component is fixedly secured in

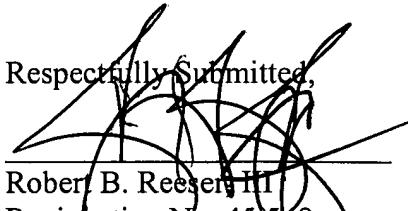
position during machining of the component...inspecting the component using an inspection tool while the component is coupled to the fixture, wherein the inspection tool includes a probe having at least a first and a second probe tip...positioning the first probe tip relative to the component...positioning the second probe tip relative to the component and relative to the first probe tip wherein the first probe tip is slideably coupled to the probe, and the second probe tip is slideably coupled to the probe."

Workman et al. do not describe nor suggest a method for inspecting a component using an inspection tool including a probe having first and second probe tips that are positionable relative to each other and to the component being inspected, wherein the first and second probe tips are slideably coupled to the probe. Rather, in contrast to the present invention, Workman et al. describe styli that are fixed to a probing attachment so that the styli will break upon a predetermined force to prevent damage to the probing mechanism. Accordingly, for the reasons set forth above, Claim 1 is submitted to be patentable over Workman et al.

Claims 4-6 depend from independent Claim 1. When the recitations of Claims 4-6 are considered in combination with the recitations of Claim 1, Applicants submit that Claims 4-6 are likewise patentable over Workman et al.

For at least the reasons set forth above, Applicants respectfully request the Section 103 rejection of Claims 4-6 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

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